

Application No. 10/800,492
Filed: March 15, 2004
TC Art Unit: 1751
Confirmation No.: 9279

REMARKS

Pending claims 1-26 have been rejected as obvious over Marquis et al. This rejection is respectfully traversed for the reasons given below and reconsideration is requested.

The Examiner states that Marquis et al. is silent with respect to the pH of the composition. The Applicant submits that the Examiner has misread the prior art reference. The Examiner is referred to col. 2, lines 6-7, of Marquis et al. where it is stated that the disclosed composition has a "neutral pH (or slightly acidic or slightly basic pH)." At the cited place, Marquis et al. makes no reference at all to buffering the disclosed composition and teaches that whether the pH of the composition is acidic or basic is not important. In contrast, claim 1 of the instant application requires "an effective amount of a pH-buffering agent that is chemically inert in said composition and that maintains the pH of said composition between approximately pH 2 and pH 6.5." The Examiner states that it would be obvious to modify the composition of Marquis et al. to obtain Applicant's invention. However, such a modification of Marquis et al. would be contrary to the teachings of that reference. It is settled law that a reference may not be applied in a manner that runs counter to its teachings.

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The Examiner also states that one skilled in the art "would have been able to modify" the composition of Marquis et al. With respect, Applicant points out that being "able to modify" a reference is not the standard. The suggestion to modify the reference must come from the reference itself. Otherwise, an Examiner is using impermissible hindsight to reconstruct the Applicant's claims based on the teachings in the *Applicant's* specification.

Finally, the Examiner justified his modification of Marquis et al. by stating that an acidic composition would "further increase the effectiveness of said paint removing compositions." Besides the fact that there is no suggestion at all in Marquis et al. of such an effect of acidifying the disclosed compositions, the Applicant submits with respect that acidification within the range recited in the instant claims would not even have the effect proposed by the Examiner in that *acid-based* stripping is known to require a lower pH than that recited in the Applicant's claims.

Thus, Applicant submits that the rejection has been overcome and all claims are in condition for allowance. Such action is respectfully requested.

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The Examiner is encouraged to telephone the undersigned attorney to discuss any matter that would expedite allowance of the present application.

Respectfully submitted,
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